

### **REMARKS**

The applicant respectfully requests reconsideration in view of the amendments and the following remarks. Support for newly added claim 11 can be found in claim 1 and the specification at page 6, lines 13 to page 7, line 4. Support for newly added claims 12-18 can be found in the original claims 2-10. Support for newly added claims 19-22 and 25-26 can be found in the specification at page 10, lines 5 to 9 of the specification. Support for newly added claim 23 can be found in the specification at page 9, lines 14 to 31. Support for newly added claim 24 can be found in the specification on page 8, lines 24 to 28.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Löffelholz, US 2003/0230167 ("Löffelholz"). Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brown, US 6338832 ("Brown"). The applicant respectfully traverses these rejections.

#### **Rejection Over Löffelholz**

Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Löffelholz. It is pointed out that Löffelholz was published on **December 18, 2003** and has a U.S. Filing Date of March 7, 2003. The present patent application was filed in the US on July 11, 2006, has a PCT filing date of **August 31, 2004** and a German Priority date of September 12, 2003. Since this application is considered filed as of the PCT filing date August 31, 2004 and the Löffelholz reference published less than a year from the filing date (December 18, 2003), **the Löffelholz reference would qualify as prior art under 35 USC 102(e) and not (b).**

With respect to obviousness, Löffelholz would not qualify as prior art for the following reasons:

It is noted that 35 U.S.C. 102(e) prior art being applied under 35 U.S.C. 103 if it was co-owned at the time of filing this application can be removed as prior art. In accordance to the stated requirement pertaining to establishment of common ownership provisioned in MPEP § 706.02(l)(1), Applicants submit the following statement:

"Application **10/571,153** and Published Application US 2003/0230167 were both owned by H.C. Starck GmbH ("H.C. Starck") at the time the invention of Application **10/571,153** was made."

It is noted that the Canadian counterpart of Löffelholz has the earliest publication date (September 12, 2003)(see attachment of family search of Löffelholz). The applicant is in the process of procuring a certified English translation of their priority document which the applicant believes will entitle them to an effective filing date of September 12, 2003. Therefore, none of the corresponding Löffelholz references would have published prior to the critical September 12, 2003 date.

Therefore, Applicants respectfully submit that Löffelholz does not qualify as a prior art reference for an obviousness rejection under 35 U.S.C. 103(a).

In addition thereto, Löffelholz merely discloses general information on how more or less spherical valve metal oxides can be obtained, but does neither specify the exact process parameters as claimed in the amended claims nor the BET surface of the materials obtained. Consequently, the applicant believes that the amendment should overcome the rejection over Löffelholz.

It was surprising and could not be anticipated by a person of ordinary skill in the art knowing Löffelholz by which process parameters a valve metal oxide powder having a porous, sponge-like morphology having a spherical particle shape and a predetermined particle size can be obtained. Consequently, the present, amended claims are not only novel over Löffelholz. For the above reasons, this rejection should be withdrawn.

### **Rejection Over Brown**

Claims 1-10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Brown. Brown does not disclose the different parameters as claimed now, and in particular does not disclose the different ratios of flow rates and the molar concentrations.

It was an object of the present invention to provide novel valve metal pentoxides. Brown is concerned with valve metal pentoxide powders that are not very porous and may consist of agglomerates of fine powders.

If the particle size of the powders is decreased, the specific surface area is increased and vice versa. Brown teaches how the particle size may be controlled in order to control the specific surface area.

In contrast thereto, the powders according to the present invention show very, high specific surfaces while at the same time having a large particle size, which is the result of the sponge-like morphology of the valve metal powder particles according to the invention, as can be seen e.g. in Figure 3. Brown merely teaches control of the powder particle size in order to control the specific surface area; but does not disclose a way on how to achieve the highly

porous, sponge-like morphology of the powders according to the invention. Brown teaches away from the applicant's claimed invention.

It was surprising and could not be anticipated by a person of ordinary skill in the art knowing Brown by which process parameters a valve metal oxide powder having a porous, sponge-like morphology having a spherical particle shape and a predetermined particle size can be obtained. Consequently, the present, amended claims are not only novel over Brown, but also the present invention is non-obvious over Brown.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

A one month extension of time has been paid. Applicant believes no additional fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 13077-00124-US from which the undersigned is authorized to draw.

Dated: October 30, 2008

Respectfully submitted,

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